

REMARKS

I. The Claims Are Not Indefinite Under 35 U.S.C. § 112

The Examiner has rejected claims 9-13, 24-28, and 30 as allegedly being indefinite for reciting trademarked product names. Applicants disagree. However, in order to further the prosecution of the present application, without acquiescing to the Examiner's position, Applicants herein cancel the dependent claims that recite trademarked product names. Applicants reserve the right to prosecute the cancelled claims (or similar claims) in the future. Applicants further note that the pending independent claims encompass the cancelled subject matter (i.e., the cancellation of the dependent claims does not remove this subject matter from the scope of the independent claims).

II. The claims are novel and non-obvious

The Examiner has rejected the claims as being obvious in view of Hallman (U.S. Pat. No. 5,800,904) in combination with Weberg (6,203,911) and/or Michaels (5,826,396). Applicants respectfully disagree and believe that the Examiner's primary reference, Hallman, has been misinterpreted by the Examiner.

The claimed invention relates to compositions comprising fixed images in filled polymeric material comprising a polymer component and an inorganic filler. The specification of the present invention explains that such materials have not been amenable to incorporation of high quality fixed images because of their physical properties that resist alteration (i.e., the very properties that make them desirable for use as solid surface materials). Manufacturers of such materials (e.g., DuPont with its CORIAN products) have had limited success in their ability to provide a broad palette of bright colors and images because of this physical barrier. Indeed, over decades of research in this area, the CORIAN product line, even today, has limited offerings—with each new development (none of which approximate the capabilities provided the present invention) heralded by DuPont as a major achievement. Thus, the present invention provides materials that have been elusive to very large and motivated parties.

The Hallman reference, contrary to the Examiner's arguments, is completely in line with the above discussion. Hallman also fails to put fixed images into the claimed materials. Rather than putting fixed images into filled polymeric material comprising a polymer component and an

inorganic filler, Hallman puts images into a decorative layer—which specifically is NOT a filled polymeric material comprising a polymer component and an inorganic filler. The very language in Hallman cited by the Examiner highlights this point. Column 7 of Hallman explains that materials of Hallman have layers made of different materials (shown, for example, in the drawings). The substrate layer is made of weaker materials that are amendable to the incorporation of fixed images. The support layer may be made of filled polymeric materials. The support layer is described as having an inorganic wear layer added to its top.

Column 8 states that there is a decorative layer that may be formed by printing on either the back of the substrate layer or top of the support layer. A laundry list of printing techniques are described. Notably, some of these techniques can be applied to the support layer because they involve painting on the surface rather than putting color in the material. Dye sublimation is one of the listed techniques in the laundry list with no mention that it can or should be used with the support layer. There is no suggestion or teaching that dye sublimation be used to print into the support layer (i.e., as opposed to using dye sublimation with the substrate layer or with the inorganic wear layer that is on the top of the support layer). Indeed, based on the techniques known in the art, any attempt to do so would fail. As described and proven by experimental testing in the specification of the present invention, dye sublimation methods of the prior art FAIL to provide materials as presently claimed. The Examiner appears to take the position that the quality of the image placed into the materials would inherently be achieved by dye sublimation methods. This is an unsupported statement and is directly contrary to the scientific evidence provided in the specification of the present invention that demonstrates the exact contrary point. The law requires that inherency be demonstrated as a matter of scientific certainty. Inherency cannot be shown by possibilities or probabilities. In the present case, the data shows that there is no possibility or probability, let alone a certainty, because Hallman provides no method for achieving the claimed invention.

Thus, Hallman does not teach or suggest thermal printing into the support layer. Furthermore, even if Hallman did make such a suggestion, there is no enabling teaching in Hallman that would permit achieving the compositions claimed in the present invention.

Applicant respectfully submits that because there is no teaching or suggestion of all of the claim limitations, the Examiner has failed to set forth a *prima facie* case of obviousness. As such, Applicant requests that the rejection be withdrawn.

CONCLUSION

All grounds of rejection of the Office Action have been addressed and reconsideration of the application is respectfully requested. It is respectfully submitted that Applicant's claims as amended should be passed into allowance. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicant encourages the Examiner to call the undersigned collect at 608.218.6900.

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